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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/802,531 | 03/15/2004 | Andreas P. Heiner | 944-003,204 | 3521 |

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| EXAMINER |
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HAN, QI

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| ART UNIT | PAPER NUMBER |
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2626

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08/10/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/802,531

Applicant(s)

HEINER ET AL.

Examiner

QI HAN

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-15, 17-27 and 32-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-15, 17-27 and 32-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Response to Amendment

3. This communication is responsive to the applicant's amendment and RCE both filed on 06/02/2009. The applicant(s) amended claims 1, 15 and 32 (see the amendment: pages 2-6).

The examiner withdrew the rejection regarding claims 3 and 7 (and their dependent claims 5, 7, 19, 21) under 35 USC 112 1st, because the applicant convinced the examiner that the referenced content of the specification provided in the argument (see Remarks: paragraph 2) substantially supports the claim(s). However, the rejection for previously amended claims 6 and 20 will be sustained because they introduced new matter and the referenced content (page 3, lines 17-19) provided by the applicant (see Remarks: paragraph 3) does **not** specifically describe and/or fully support the amended claims, as a whole (see detail in the rejection below).

Response to Arguments

4. Applicant's arguments filed on 06/02/2009 with respect to the claim rejection under 35 USC 103, have been fully considered but are moot in view of the new ground(s) of rejection (see detail below).

Claim Rejections - 35 USC § 112

5. Claims 6 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 6 and 20, the amended limitation of “wherein parts of said translation data in said primary language that are irrelevant to the present or anticipated context are deleted, substantially while the selected subset of phrases in said primary language is added”, introduces new subject matter, because it, as a whole, is not **specifically** disclosed in the original specification. It is noted that the referenced content of the specification (page 3, lines 17-19) provided by the applicant (see Remark: page 8, paragraph 3) does **not fully** support the claimed limitation as a whole.

Claim Rejections - 35 USC § 103

6. Claims 1, 4, 8-15, 18, 22-27 and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over COX et al. (US 7,272,377 B2) hereinafter referenced as COX in view of

FRANZ at al. (US 6,266,642 B1) hereinafter referenced as FRANZ.

As per **claim 15**, COX discloses 'system and method of ubiquitous language translation for wireless device (apparatus)'(title), comprising:

"a language translation device (Fig. 5 and Fig. 1, 12) that includes a database configured to accommodate translation data, the language translation device being equipped to provide a number of language translation services to a user, and the language translation device being responsive to a contextual translation data update signal that updates the database", (see Figs. 1 and 5; col. 1, lines 13-67, 'language translation module'; and col. 4, lines 16-59, 'providing ubiquitous language translation services using a wireless device (language translation device)', 'if the ASR (automatic speech recognition), language translation and speech synthesis functions (read on a number of language translation services, which necessarily and inherently include database(s), such as translation database/table/dictionary for implementing the functions) are performed locally on the wireless device 12, then the only information transmitted (being responsive) to the wireless device by the network is the updated language priority listing (contextual translation data update signal)', 'multi-language database module 30 stores the various data necessary to translate the source language message into variety of target languages' and 'such data may be stored in database 30 or some or all of the information may be downloaded (updated) to the wireless device 12', which implies that database/module storing the data/information in the device is updated; also see col. 4, line 13-21);

"an electronic data input and output module (Fig. 5, combination of 92 and 100), configured to provide the contextual translation data update signal to the language translation device, the electronic data input and output module being responsive to a context change signal

[indicative that the database may need to be updated]" (col. 4, lines 16-59, 'information transmitted to the wireless device by the network is the updated language priority listing', 'some or all of the information may be downloaded (input) to the wireless device 12', mechanism 'communicating with the network' can also read on the input and output module; Fig. 3 and col. 6, line 35 to col. 7, line 3, 'target language lists may be transmitted to the wireless device', 'display 60 (output device)' shows that 'menu 64 (output) includes a listing (corresponding to the context change signal) of available target languages');

"wherein the contextual translation data update signal is input into the apparatus, and the context change signal is output from the apparatus" (as stated above).

"wherein the present or anticipated context is a setting in a country having a primary language different from a language in which the user is fluent" (COX: Fig. 3 and col. 5, lines 30-39, 'France', wherein 'geographical information' and/or 'target language list' is/are read on claimed setting).

It is noted that COX's discloses a functionally similar mechanism as claimed "a context comparator for providing the context change signal if the translation data is insufficient to cover a present or anticipated context of the apparatus" (Fig. 1 and col. 6, lines 25-29, 'the database 28 stores demographic information..., such that the network can compare the location of the wireless device 12 to the detailed demographic data and transmit (provide) the prioritized target language or group of prioritized target languages to the wireless device 12'; and col. 5, lines 30-65) in network, but it is not physically on the apparatus (such as mobile terminal). However, COX further discloses that 'the language and location database 28 may also be included in any other module' and 'the particular location of these modules in the network, or on the wireless device is

immaterial and any convenient location for them is considered' (col. 8, lines 44-48). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to recognize that a context comparison mechanism for providing context change signal can be either in a network or on an apparatus (such as wireless device) based on considering convenient location for the related functions, and to combine different teachings of COX by providing a context comparison mechanism with a context change signal in an apparatus (such as wireless device), as suggested by COX, for the purpose (motivation) of considering convenient location for the related function modules (COX: col. 8, lines 46-49), because when the ASR, language translation, and speech synthesis functions are performed on the device (COX: col. 4, lines 43-47), performing the related context comparison on the device would be considered as suitable choice and/or convenient location for the processing, which is within the scope of capability of the skilled person in the art and the result would be predictable.

COX does not **expressly** disclose the context change signal "**indicative** that the **database** may need to **be updated**" and "therein said updates includes a selected subset of phrases in said language that are suitable for said setting". However, the similar feature is well known in the art as evidenced by FRANZ who discloses method and portable apparatus for performing spoken language translation' (title), comprising 'portable unit' such as 'laptop computer' or 'cellular telephone' performing translation (col. 6, lines 16-40), 'allow users to remotely update vocabularies (database storing phrases) ...to add (update) new words (subset of phrases) or names or expressions and their translations' (Fig. 2 and col. 9, lines 22-40). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to recognize that updating local database (or vocabularies) is necessarily or inherently through a

user or scheduled request (and/or a confirmed information, i.e. corresponding the context change signal), and to modify COX by providing local database/vocabularies for translations and a mechanism of updating the database/vocabularies as needed by users, as taught by FRANZ, for the purpose (motivation) of providing speech translation improvements for the systems (FRANZ: col. 8, lines 1-3) and/or providing remotely extended translation capabilities to retrieve additional words/phrases and their translations to be stored in a portable unit (col. 6, lines 35-40).

As per **claim 18** (depending on claim 15), the rejection is based on the same reason described for claim 15, because it also reads on the limitations of claim 18.

As per **claim 22** (depending on claim 15), the rejection is based on the same reason described for claim 15, because it also reads on the limitations of claim 22.

As per **claim 23** (depending on claim 15), the rejection is based on the same reason described for claim 15, because it also reads on the limitations of claim 23.

As per **claim 24** (depending on claim 23), COX in view of KRAEMER further discloses "the indication of at least one translation need or desire includes identification of a language in which the user is fluent" (COX: col. 5, lines 33-35, 'English speaking person'; Fig. 3 and col. 6, lines 38-45 'source language'; also see KRAEMER: p21).

As per **claim 25** (depending on claim 23), COX in view of KRAEMER further discloses "the indication of at least one translation need or desire includes identification of a particular word or phrase that the user will, or may, need to have translated" (COX: col. 1, lines 50-64, 'a source language speech input' comprising 'words, sentences, and phrases in a natural spoken language', 'recognizes (identifies) source expressions in the source language'; also see KRAEMER: p21).

As per **claim 26** (depending on claim 23), COX in view of KRAEMER further discloses "the number of language translation services is zero if the user is in, or arriving at [from], a country where the user speaks fluently" (COX: Fig. 3, wherein one of ordinary skill in the art would recognize that when the languages in block 64 and 62 are the same, there is no need for translation (the services is zero)).

As per **claim 27** (depending on claim 15), the rejection is based on the same reason described for claim 15, because it also reads on the limitations of claim 27, wherein 'speech synthesis' disclosed by COX reads on the claimed "at least on text-to-speech feature".

As per **claims 1, 4 and 8-13**, they recite a method. The rejection is based on the same reason described for claims 15, 18 and 22-27 respectively, because the method claims and apparatus claims are related as apparatus and method of using same, with each claimed element's function corresponding to the claimed method step.

As per **claim 14**, it recites a computer readable medium. The rejection is based on the same reason described for claim 1, because it recites the same or similar limitations as claim 1.

As per **claim 32**, the rejection is based on the same reason described for claim 1, because it recites the same or similar limitations as claim 15.

As per **claim 33**, the rejection is based on the same reason described for claim 1, because it also reads on the limitations of claim 15, wherein, one of ordinary skill in the art would have recognized that after downloading/updating the database the language translation, it would have no need for external translation resource support.

As per **claim 34**, the rejection is based on the same reason described for claim 1, because it also reads on the limitations of claim 15.

7. Claims 3, 5, 7, 17, 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over COX in view of FRANZ as applied to claim 15, and further in view of ZHOU at al. (US 2004/0167770 A1) hereinafter referenced as ZHOU.

As per **claim 17** (depending on claim 15), COX in view of FRANZ does not expressly disclose "said subset of phrases is selected from a group comprising phrases for a hotel, airport, hospital, and restaurant". However, the feature is well known in the art as evidenced by ZHOU who discloses 'methods and systems for language translation' (title) providing 'translation service' to 'a wireless mobile device through a selective downloading of information from a server' (abstract), comprising 'specialized database' including 'specific words and phrases associated with a destination city, such as particular hotel, street names, restaurants, tourist attractions, etc' and 'other types of specialized database' for the translation (p37-p38), which is reasonably read on the claimed limitation in light of specification (page 3, lines 9-11). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify COX in view of FRANZ by providing specific phrases (subset of phrases) associated with different types of specialized database for the translation, as taught by ZHOU, for the purpose (motivation) of providing user desired one or more specialized database in a language translation and/or implementing a user-driven term replacement scheme for simplifying the translation process (ZHOU: p38; abstract).

As per **claim 19** (depending on claim 17), COX in view of FRANZ and ZHOU further discloses "the anticipated context is entered by the user" (COX: col. 7, lines 54-62, 'the user ...to choose (enter) the target language (anticipated context)').

As per **claim 21** (depending on claim 17), COX in view of FRANZ and ZHOU further discloses "the setting or location is sensed by, determined by, or signaled to the mobile terminal" (COX: col. 5, lines 3-18).

As per **claims 3, 5 and 7** (depending on claim 1), the rejection is based on the same reason described for claims 17, 19 and 21 respectively, because the method claims and apparatus claims are related as apparatus and method of using same, with each claimed element's function corresponding to the claimed method step.

8. Claims 6 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over COX in view of FRANZ as applied to claim 15, and further in view of KRAEMER at al. (US 2003/0065504 A1) hereinafter referenced as KRAEMER.

As per **claim 20** (depending on claim 15), as best understood in view of the claim rejection under 35 USC 112 1st (see above), even though COX in view of FRANZ discloses the updates substantially including that "the selected subset of phrases in said primary language is added" (see above), COX in view of FRANZ does not **expressly** disclose handling "parts of said translation data in said primary language that are irrelevant to the present or anticipated context, by deleting said parts". However, the feature is well known in the art as evidenced by KRAEMER who discloses 'instant verbal translator' (title), providing 'mobile translation capabilities' (abstract), comprising mobile terminal such as 'personal data assistants (PDA), lap top computers' including 'database' and 'communication interface' (including input and output signal) (p(paragraph)18-p 19), 'the local/proximate database receives updated information (corresponding to contextual translation data update signal) from the centralized and/or regional

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databases as needed (by user)' and 'provide translations for a limited number of languages' and 'the languages stored in the local database may be substituted with another language upon establishing a wired or wireless connection with a central/regional database and downloading (adding) the desired language while deleting an undesired language (p24) that reads on the claimed "translation data in said primary language that are irrelevant to the present or anticipated context" in light of the specification (page 6, 21-24). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify COX in view of FRANZ by providing a mechanism of deleting undesired/irrelevant translation data (such as some undesired language) when downloading/adding desired language (or new words), as taught by KRAEMER, for the purpose (motivation) of providing mobile translation capabilities to any person at any location (KRAEMER: abstract) and/or reducing the complexity/requirement of processing capabilities for local device(s) (mobile terminal) (KRAEMER: p24) so as to save/reduce storage requirement for the local device(s).

As per **claim 6** (depending on claim 1), the rejection is based on the same reason described for claim 20, because it also reads on limitations of claim 6.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to QI HAN whose telephone number is (571)272-7604. The examiner can normally be reached on M-TH:9:00-17:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil can be reached on (571)-272-7602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

QH/qh
August 7, 2009
/Qi Han/
Primary Examiner, Art Unit 2626